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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,674	08/02/2001	Salim A. Nathoo	NAT 003 PAT	6752

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EXAMINER

OSTRUP, CLINTON T

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

Application No.

09/920,674

Applicant(s)

NATHOO, SALIM A.

Examiner

Clinton Ostrup

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 and 19 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**~~DETAILED ACTION~~**

Claims 1-13 and 19 are pending in this application.

***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application-by-application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: there are numerous misspellings and the essential statements are incomplete. For example, the statement "I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as **,mended** by any amendment specifically referred to above." (Bolding added for emphasis.)

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***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 14 has been renumbered claim 19.

Claim 2 is objected to because of the following informalities: the claim contains multiple periods. Each claim should begin with a capital letter and end with a period and periods may not be used elsewhere in the claims except for abbreviations. See:

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~~MPEP 608.01(m). Claim 2 is also objected to because it lacks a conjunction between~~  
the term "agent" and the term "c." Appropriate correction is required.

Claims 4, 7, and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claims 4, 7, and 8 are limitations already present in claim 1, the claim they depend from, thus, they do not further limit claim 1.

***Election/Restrictions***

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Applicant's election of claims 1-13 and claim 19 in Paper No. 19 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

As discussed in the Interview Summary, if the composition of Claim 1 is found allowable, pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claim 14, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction

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requirement, would be rejoined. However, process claim 14 is hereby restricted from examination until allowable subject matter is indicated.

Claim 14 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim, currently claim 1 is generic. The election of Group I, claims 1-13 was made **without** traverse in Paper No. 4.

### ***Specification***

The disclosure is objected to because of the following informalities: Page 4, second full paragraph contains references to US Patents using the “#” symbol. US Patents should be referred to using the “No.” abbreviation, not the “#” symbol.

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The use of the trademark PLURONIC F127<sup>TM</sup> has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

There have been numerous errors in the specification, as noted above, as well as numerous obvious misspellings and punctuation errors such as, page 2, line 21, wherein the letter “y” appears to be inadvertently typed in the sentence; page 7, line 1, there are two periods at the end of the sentence; and on page 9, Table 5, “Dequest 2010” is misspelled as “Deguest 2010”. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors.

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Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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~~Claims 1-13 and 19 are rejected under 35 U.S.C. 112, second paragraph, as~~  
being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the carrier", however, there is insufficient antecedent basis for this limitation in the claim.

Claims 11, 12 and 13 are confusing because it is unclear what the percentages as claimed are based upon. It appears applicant intended the percentages to be based upon weight and the claim was searched and examined as such. However, appropriate correction is required.

Claims 1-13, and 19 are confusing because it is unclear if the percentages as claimed are based upon the total weight of the composition or some other relative weight factor. The examiner assumed for search and examination purposes that

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applicant intended all weight percentages to be based on the total weight of the composition, however, appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, 7, 8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Frazier et al., 4,980,152.

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~~Frazier et al., teaches making clear gel compositions comprising hydrogen~~  
peroxide, Pluronic F127, citric acid, sodium fluoride, and water. See: col. 4, example 5 and col. 5, example 6. Pluronic F127 is the specific polyoxyethylene-polyoxypropylene non-ionic surfactant gelling agent used in the instant invention, and sodium fluoride is a catalase-inhibiting compound. Therefore, the composition as claimed instantly in claims 1, 4, 5, 7, 8, and 11 are clearly taught by Frazier et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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~~The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148~~

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4-8, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frazier et al., 4,980,152, as applied to claims 1, 4, 5, 7, 8, and 11 above, and further in view of Oxman et al., 6,312,666.

Frazier et al., teaches making clear gel compositions comprising hydrogen peroxide, Pluronic F127, citric acid, sodium fluoride, and water. See: col. 4, example 5 and col. 5, example 6. Pluronic F127 is the specific polyoxyethylene-polyoxypropylene non-ionic surfactant gelling agent used in the instant invention, and sodium fluoride is a catalase inhibiting compound, thus the composition comprising the compounds of the tooth bleaching composition, as claimed instantly in claims 1, 4, 5, 7, 8, and 11 are clearly taught by Frazier et al. The primary reference claims sodium lauryl sulfate in the gel compositions and therefore teaches instant claims 3 and 20. See: claims 1-5 and 20. The primary reference teaches sodium hydroxide added to potassium phosphate as a buffering agent.

Although Frazier et al., teach the specific compounds of claims 1, 4, 5, 7, 8, and 11, the reference lacks the peroxide of instant claim 6.



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~~Oxman et al., teach compositions and methods of using the compositions for~~  
whitening teeth. The secondary reference teaches whitening agents as being selected from hydrogen peroxide and its urea complex, carbamide peroxide, which are known in the art. The secondary reference teaches tooth-whitening gels comprising Pluronic F127, hydroxide, and water.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Frazier et al., by using carbamide peroxide, a well known hydrogen peroxide complex because of the reasonable expectation of obtaining a tooth whitening gel composition comprising a hydrogen peroxide compound that would provide similar tooth whitening properties.

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Claims 1-8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frazier et al., 4,980,152 and Oxman et al., 6,312,666 as applied to claims 1, 4-8, and 11-12 above, and further in view of Day 6,479,038.

The combined references above teach tooth whitening gel compositions comprising a polyoxyethylene-polyoxypropylene non-ionic surfactant, peroxide, water, and a catalase inhibitor, as described above, however the combined references lack the specific chelating system of instant claim 2, the chelating agent of claims 9 and 10, and the surfactant of claim 13.

Clipper et al., teach aqueous oral gel compositions comprising a surfactant system, which comprises a Pluronic type and a polysorbate type surfactant. The secondary reference specifically teaches Tween 20 as the polysorbate type surfactant, thus meeting the limitation of instant claim 13. The reference teaches gel compositions

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~~comprising hydrogen peroxide, water, and Tween 20 and teaches fluorinated sodium~~  
calcium pyrophosphate as optional ingredients.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the teachings of the combined references above by adding Tween 20 as a polysorbate type surfactant because of the expectation of obtaining a surfactant combination which serves as a solubilizing, dispersing, emulsifying, wetting, and viscosity-control agent, while effectively solubilizing flavorants.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on M-F (8:30am-5:00pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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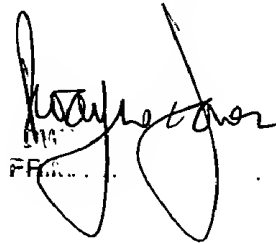
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Clinton Ostrup

Examiner

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December 23, 2002



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